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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/341,328	07/06/1999	SATOSHI MIKAMI	KINOSHITACA	4999

7590 02/24/2003
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EXAMINER

PULLIAM, AMY E

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/341,328

Applicant(s)

MIKAMI ET AL.

Examiner

Amy E Pulliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt of Papers

Receipt is acknowledged of the Request for Extension of Time and the Amendment D, both received by the Office on October 9, 2002.

New Matter

The amendment filed October 9, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "and a cosmetic composition weakly adhered to the natural organic palpable powder."

The examiner recognizes that Applicant is attempting to more clearly explain the invention, as requested by the examiner in the last office action. However, the language stated above is not supported by the specification. The examiner could only find support in the specification for a generic teaching to the use of the article as a cosmetic applicator. Unfortunately, this does not give support for a composition weakly adhered to the original powder. Therefore, Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-41 and new claim 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,496,544 to Mellul *et al.*

Mellul *et al.* disclose a cosmetic composition for skin consisting of a powder and a silicone resin mixture (abstract). Mellul *et al.* further teach that face powders and the like usually consist of coloured or non-coloured powders and a fatty binder, which is then applied to the skin by means of an applicator such as a sponge, powder puff, or brush (c 1, l 13-23). Mellul *et al.* disclose a cosmetic composition with a powder comprising a solid particulate phase mixed with a fatty binder containing a silicone mixture (c 2, l 48-58).

Mellul *et al.* teach an organic powder, which suggests applicant's claim to a natural organic powder. It is the position of the examiner that the term organic can be interpreted to mean natural, being that organic can be defined as something derived from living organisms. Therefore, Mellul *et al.*'s teachings to any organic powder render applicant's claims obvious. Additionally, the examiner refers to column 6, line 9 of the reference, which teaches that starch can be included in the powder composition as a filler. Starch is a natural, organic material, and therefore fulfills the requirement for a natural, organic material in the powder composition. Furthermore, applicant's claims 24-29 include specific examples of what applicant is referring to as a natural, organic powder. This list includes cellulose and collagen, among others, and is therefore rendered obvious by Mellul *et al.*'s teaching of starch, as well as the teaching in column 6, line 56, where Mellul *et al.* teach that collagen can be included in the powder composition.

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It is the position of the examiner that Mellul *et al.*'s invention reads on applicant's claims. Applicant is claiming an applicator with a powder adhered to the side which will touch the skin. Mellul *et al.* teach that powder puffs, applicators, and sponges are well known in the cosmetic art to apply facial powder and the like to the skin. Further, applicant claims that the powder adheres to the applicator through a treatment with a resin mixture. Mellul *et al.* teach a powder mixed with a silicone resin mixture (weight percents discussed in c 2, l 61), and teaches that it is applied to the skin in the usual methods (c 7, l 51-52). Mellul *et al.* do not teach the specific particle size of the powder. However, it is the position of the examiner that the specific particle size is a limitation that would be routinely determined by one of ordinary skill in the art, through minimal experimentation, as being suitable, absent the presentation of some unusual and/ or unexpected results. The results must be those that accrue from the specific limitations. Therefore, it is the position of the examiner that one of ordinary skill in the art would have been motivated to use a well known applicator (as discussed by Mellul *et al.*) to apply a cosmetic composition comprising a powder and a silicone resin mixture, as taught by Mellul *et al.*. One of ordinary skill in the art would expect an improved cosmetic composition. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's arguments filed October 9, 2002 have been fully considered but they are not persuasive.

Applicants have amended the claims to recite “the powder being adhered to the base layer by coating a treatment comprising the powder onto the base layer and drying the treatment thereon.” Applicant first argues that the cited art does not disclose this new limitation. However, this argument is not persuasive. According to the MPEP section 2113, “even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production, If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir. 1985). Therefore, the new limitation, drawn to the process of adhering the powder to the base layer, does not render patentable distinction to the claims. Patentable distinction may only be rendered to composition claims by showing that there is a material difference in the actual products. As discussed in the above rejection, it remains the position of the examiner that the cited reference does implicitly teach a powder being adhered to the based layer. Additionally, any differences to be shown between the cited product and Applicant’s claimed product must be expressed in the claim language.

Applicant also argues that the reference does not teach natural, organic materials. As stated in the above rejection, the reference’s teaching to any organic powder renders applicant’s claims obvious because organic can be interpreted to mean derived from living organisms. Furthermore, the reference teaches broadly to the use of any organic powder. Thus, absent a showing of criticality between the powders specifically disclosed in the reference, and the powders specifically claimed by Applicant, the reference renders Applicant’s claims obvious.

Applicant also argues that the examiner's comments regarding particle size as improper. Applicant states that a 103 rejection can not be based on a mere possibility. The examiner finds this argument unpersuasive. As stated previously, the reference is silent to a particular particle size. However, the reference is clearly using particles, as they clearly refer to powders throughout the disclosure. Furthermore, the determination of a particular particle size is within the skill of the ordinary worker as part of the process of normal optimization. It is recommended that Applicant provide data showing that the particular particle size claimed by Applicant has unexpected results. Otherwise, it remains the position of the examiner that, in the cosmetic art, manipulation and selection of particular particle sizes is a well known step in the optimization of a particular product. Therefore, mere particle size alone does not render patentability to a composition.

For these reasons, the above rejection is maintained.

Claims 12-41, and new claim 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,776,497 to Lagrange *et al.*. Lagrange *et al.* disclose a mineral or organic particle based product, wherein the product is a powder which consists of mineral or organic particles smaller than 200 microns (abstract). Lagrange *et al.* further teach that the product is to be used in cosmetics (c 1, l 10, and the reference specifically discusses the formulation's use as a powder to be applied with a powder puff or a brush (c 14, ex. 7). Although Lagrange *et al.* teach in general that the particles be less than 200 microns, the reference further teaches that the particles, in particular be between 1 and 20 microns (c 4, l 46). Furthermore, Lagrange *et al.* teach that substances such as chitin, cellulose, wool, and silk can all be included in the composition (c 5, l 35-44). Additionally, Lagrange *et al.* teach that the

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makeup compositions of the present invention can also contain thickeners, and anionic and cationic substances (c 9, 1 23-24). It is the position of the examiner that the teachings of Lagrange *et al.* suggest the limitations of applicant's instant claims. Although Lagrange *et al.* do not use the language "firmly adhered" to, for the same reasons discussed in the first rejection, this is not considered to patentably distinguish the art from the instant applicant. One of ordinary skill in the art would look to the teachings of Lagrange *et al.* to formulate a cosmetic composition comprising a an applicator, and a powdered substance wherein the powdered substance is firmly adhered to the applicator. Without firm adherence, the applicator would not function as desired. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Applicant's arguments regarding the above rejection have been considered but are not found to be persuasive for the reasons stated above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E Pulliam whose telephone number is 703-308-4710. The examiner can normally be reached on Mon-Thurs 7:30-5:00, Alternate Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

A. Pulliam
Patent Examiner
Art Unit 1615
February 11, 2003


S. Kishore, PhD
Primary Examiner
Group 1500